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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.       | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------------|------------------|
| 10/697,916  | 10/29/2003  | John Gerard Speare   | 13768-449                 | 9720             |
| 47973   | 7590        | 02/23/2006           |                           |                  |
| WORKMAN NYDEGGER/MICROSOFT<br>1000 EAGLE GATE TOWER<br>60 EAST SOUTH TEMPLE<br>SALT LAKE CITY, UT 84111 |             |                      | EXAMINER<br>COLIN, CARL G |                  |
|   |             |                      | ART UNIT<br>2136          | PAPER NUMBER     |

DATE MAILED: 02/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                        |                     |  |
|------------------------------|------------------------|---------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b> | <b>Applicant(s)</b> |  |
|                              | 10/697,916             | SPEARE ET AL.       |  |
|                              | <b>Examiner</b>        | <b>Art Unit</b>     |  |
|                              | Carl Colin             | 2136                |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 02 December 2005.

2a) This action is FINAL.                    2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-44 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-44 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on 29 October 2003 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a)  The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

|  |  |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                    | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)           | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ . | 6) <input type="checkbox"/> Other: _____ .                                   |

## **DETAILED ACTION**

### *Response to Arguments*

1. In response to communications filed on 12/2/2005, applicant has amended claims 1, 8-10, 15, 22, 23, 25, 31-32, 37, and 42. The following claims 1-44 are presented for examination.

1.1 Applicant's arguments, pages 18-20, filed on 12/2/2005, with respect to the rejection of claims 1-44 have been fully considered but they are not persuasive. Applicant has amended the claim limitations to further limit the claimed invention. However, the addition or modification of right expression does not render the claim patentable over the prior art. In response to applicant's response that England can only be used as prior art under 102(e), the passage cited by Examiner has been known as prior art in the patent 6,330,670 issued to England on 12/11/01. Claims 1-44 are still rejected under 35 USC 103(a) in view of Wyman, Misra, and in view of England.

### *Claim Objections*

2. Claim 10 is objected to because it should be dependent of claim 7 rather than claim 8 as the limitation of claim 10 is an alternative of claim 8 as specified in the specification on page 20, paragraph 54. Appropriate correction is required.

### *Claim Rejections - 35 USC § 103*

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3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3.1 **Claims 1-5, 7-8, 11-19, 21-22, 25-31, 34-40, and 43-44**, are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 5,204,897 to **Wyman** in view of US patent 6,189,146 to **Misra et al.**

3.2 **As per claims 1, 12, 15, 26, 29, 35, 37, and 43, Wyman** discloses in a messaging system comprising a rights management server (issuer in one embodiment or license server in other embodiment) that controls the type of operations principals can perform on protected content and a message server (delegates or license server) that receives messages and makes them available to principals or their agents, a method of pre-licensing content subject to rights management in order to allow a principal access to the content when the principal does not have access to the rights management server (column 10, lines 30-38 and column 11, lines 3-67), the method comprising acts of: receiving, by the message server (13), a message from a sending computer system (10) (column 11, lines 3-16), a message which is subject to rights management in that

access to at least a part of the message is controlled through a rights management server (25) (column 11, lines 3-16 and column 10, lines 30-58), the rights management server issuing one or more user licenses that allow one or more principals to access the at least part of the message subject to rights management (column 11, lines 3-16 and column 10, lines 30-58). **Wyman** also discloses receiving, by the message server (13) a publishing license (product use authorization) from a sending computer system (10) (column 11, lines 3-16 and column 10, lines 30-58); the publishing license containing a rights expression identifying the at least part of the message subject to rights management, specifying one or more intended recipients for the at least part of the message subject to rights management and specifying one or more rights for each of the one or more intended recipients (see column 12, lines 54-67 and column 14 lines 26-60 and see figure 2 with detailed explanation), the publishing license being previously acquired by the sending computer system (10) from the rights management server (column 11, lines 3-16 and column 10, lines 30-58). **Wyman** also discloses requesting by the message server (13) on behalf of the one or more principals, at least one use license for allowing the one or more principals access to the message wherein the request includes the publishing license to identify the at least part of the message subject to rights management server (column 11, lines 16-67 and column 7, line 30 through column 8, line 31); **Wyman** further discloses receiving, by the message server on behalf of the one or more principals, the at least one use license so that the one or more principals may obtain the at least one use license from the message server and access the at least part of the message subject to rights management without having to request the at least one use license from the rights management server (column 11, lines 16-67 and column 7, line 30 through column 8, line 31); providing by the message server to at least one or more principals

one or more of the at least one use license (column 11, lines 16-67 and column 7, line 30 through column 8, line 31). **Wyman** also discloses right expression that limits one or more principal's operation in at least one of re-licensing, printing, forwarding, and sharing of the message (see column 12, line 54 through column 13, line 8; column 13, lines 40-62 and column 14, lines 2-8; column 15, lines 7-16 and 17-63; column 20, lines 18-67; column 32, lines 32-67).

**Wyman** clearly teaches the key concept of the claimed invention as a whole and suggests using plurality of servers such as other servers or delegates to delegate request or receive grants on behalf of the client from the license server or the issuer (column 7, lines 30 through column 8, line 5). Combining or separating the tasks that can be performed by one or more servers without getting any unexpected results would be routine skill in the art, for example, an obvious design choice would be to combine the function of the issuer and the license server of **Wyman**. **Misra** in an analogous art, discloses an intermediate server receiving a publishing license on behalf of a principal, the request containing rights expression such as client ID in one embodiment and other information in different embodiment (column 15, lines 1-15 and column 16, lines 23-55 and column 17, lines 13-25 column 13, lines 12-42) for use in authenticating the request. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of **Wyman** to have the server received a publishing license containing a rights expression specifying one or more intended recipients for the at least part of the message subject to rights management and one or more rights for each of the one or more intended recipients for use in identifying the at least part of the message subject to rights management to the rights management server because if the server is not trusted it would not be appropriate to store license key information to maliciously modify the license as the license is encrypted using

the client key as taught by **Misra** (see column 15, lines 35-50). This modification would have been obvious to one of ordinary skill in the art because it allows the client to request and obtain license from the license server or the issuer and establish a trusted communications without the need to trust the intermediate server as suggested by **Misra** (see column 15, lines 35-50).

**As per claims 2, 16, and 38,** the combination of **Wyman and Misra** discloses the limitation of wherein the at least a part of the message controlled through the rights management server is encrypted, and wherein the use license comprises a content key used in decrypting the part of the message that is encrypted, for example (see Misra, column 11, table 5). Therefore these claims are rejected on the same rationale as the rejection of claim 1 above.

**As per claims 3 and 17,** the combination of **Wyman and Misra** discloses the limitation of wherein the part of the message that is encrypted is at least one of a protected contact, protected document, protected calendar item or protected meeting request, for example (see Wyman, abstract). Therefore these claims are rejected on the same rationale as the rejection of claim 1 above.

**As per claims 4, 18, and 39,** the combination of **Wyman and Misra** discloses wherein the act of requesting at least one use license further includes sending an authentication to the rights management server to verify that the message server has the authority to obtain the at least one use license on behalf of the one or more principals, for example (see Misra, column 6, lines

30-65). Therefore these claims are rejected on the same rationale as the rejection of claim 1 above.

**As per claims 5, 14, 19, 28, 36, 40 and 44,** the combination of **Wyman and Misra** discloses to have the message server requests multiple use licenses on behalf of the one or more principals so that the one or more principals may access the message on multiple machines (Wyman, column 7, lines 30 through column 8, line 22; and Misra, column 4, lines 30-58).

**As per claims 7, 21, and 30,** the combination of **Wyman and Misra** discloses the limitation of wherein the publishing license includes a reference to the one or more principals such that when the message server requests the at least one use license, the rights management server may validate that the one or more principals are intended to have access to the message, for example (see Misra, column 6, lines 30-65). Therefore these claims are rejected on the same rationale as the rejection of claim 1 above.

**As per claims 8, 22, and 31,** the combination of **Wyman and Misra** discloses the limitation of wherein the publishing license further includes at least one rights expression that limits the types of operations the one or more principals are allowed to perform with regard to copying, forwarding, and delegating the message, for example (see Misra column 7, lines 1-12; column 1, lines 10-18 and lines 34-46; column 15, lines 29-36; and Wyman, column 12, lines 15-25 and column 32, lines 32-67).

**As per claims 11, 25, and 34,** the combination of **Wyman and Misra** discloses the limitation of wherein the rights expression includes an expiration feature, which limits at least one of the number of times or a time period the at least one rights expression is available, for example (see Misra column 7, lines 1-12 and Wyman, column 12, lines 15-25 and column 32, lines 39-67).

**As per claims 13 and 27,** **Wyman** discloses the limitation of wherein the publishing license further comprises one or more of a hash used to verify the message has not changed and a signing by the rights management server used to verify that the publishing license is valid, for example (see Misra table 1).

4. **Claims 6, 9-10, 20, 23-24, 32-33, and 41-42** are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 5,204,897 to **Wyman** in view of US patent 6,189,146 to **Misra et al** as applied to claim 1 above and further in view of US Patent 6,330,670 to **England et al**.

4.1 **As per claims 6, 9-10, 20, 23-24, 32-33, and 41-42,** both references substantially teach the claimed method of claim 1. **Wyman** also discloses right expression that limits one or more principal's operation in at least one of printing, and saving the message (see column 14, lines 2-8), re-licensing the message (column 15, lines 7-16 and 17-63; column 20, lines 18-67; column 32, lines 32-67), number of times the right expression is available (column 20, lines 9-43) among many other right expressions as cited in claim 1. Neither of the references explicitly discloses storing the use license separate from the message. **England et al** in an analogous art also teaches

restriction of use license and also teaches right to copy or access such as read/write access (column 10, lines 14-25 and column 16, lines 40-50), and further teaches storing a content or a particular file wherein the at least one use license is stored by the server separate from the message in order to add security and control access to the storage of keys, for example (see column 19, lines 11-17 and column 20, lines 11-16). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method as combined above to have at least one use license stored by the server separate from the message because the separation adds security and control access to the storage of keys as suggested by **England et al.** One skilled in the art would have been lead to make such a modification as suggested by **England et al** because it would add additional security and control access to the storage of keys.

### *Conclusion*

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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5.1 The prior art made of record and not relied upon is considered pertinent to applicant's disclosure as the art discloses limited access to content where one or more principals does not need to request the use license from the server. Many of the claimed features are disclosed in these disclosures.

US Patents: 6,643,774 McGarvey 6,205,480 Broadhurst et al;

6,385,728 DeBry; 6,487,599 Smith et al; 5,742,759 Nessett et al.

5.2 Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carl Colin whose telephone number is 571-272-3862. The examiner can normally be reached on Monday through Thursday, 8:00-6:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on 571-272-3795. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*ccr*

Carl Colin

Patent Examiner

February 16, 2006



AYAZ SHEIKH

SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100